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Supreme Court of the United States.

OCTOBER TERM, 1957.

No. 673.

MINNESOTA MINING AND MANUFACTURING COMPANY, *Petitioner,*

v.

SEARS, ROEBUCK AND COMPANY AND THE PLYMOUTH RUBBER COMPANY, INC., *Respondents.*

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

THORNTON H. BROOKS,
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E. T. LEGATES,
Of Counsel.

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This is an ordinary patent suit, involving no conflict of decisions between different Courts of Appeals, no new or doubtful question of law, no conflict between the decision of the Court of Appeals and the applicable decisions of this Court or any other court, and no matter of public interest or importance.

First, petitioner asks for review of the finding of the Court of Appeals on a simple question of interpretation of a legal document, which in this case is a patent. The Court of Appeals found (1) that the specification of the Oace patent in suit comprises an "emphatic assertion" that "both

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types of plasticizers must be used," and (2) that the finding of District Judge Hayes* to the contrary is "beyond question . . . clearly erroneous" (App. 31).† Petitioner asserts that in so finding the Court decided an "important question of patent law . . . in a manner in conflict with the decisions of this Court" (Br., p. 11). Petitioner does not show wherein the Court's reversal of the District Court for clear error constitutes a decision on "a question of patent law," much less a decision of patent law "in conflict with decisions of this Court."

Nor is petitioner supported by the record as to the alleged facts relied upon to support its petition. In support of its position petitioner asserts that the specification of the patent is of such a "deeply technical" character that only a man skilled in the art can say what the patent teaches and discloses, and erroneously asserts that the experts of both parties agreed that the specification taught the use of a resin plasticizer as the sole plasticizer, contrary to the finding of the Court of Appeals. On the contrary, the teaching of the Oace specification that the two types of plasticizer are required is indubitably clear to any reader at all literate, and petitioner's continued assertion that the experts of both parties agreed that the specification taught what petitioner asserts is a gross misrepresentation (*infra*). Moreover, the Patent Office made no such finding as the teaching of the Oace patent, as petitioner also erroneously asserts.

Second, petitioner contends, as we read the petition, that the Court of Appeals in finding absence of infringement because one element specified as essential and called for by the original claims in issue‡ (8 to 20 parts of a liquid plasti-

*The findings of the District Court were the findings submitted by the petitioner, without change.

†As in Petitioner's Brief, "App." refers to appendix to the petition.

‡The broadened reissue claims we refer to in our appendix (*infra*).

cizer) was entirely omitted in the accused product, the plasticizer of which was completely resinous, relied upon and enunciated a doctrine of known equivalents, as to which, petitioner asserts, there is some controversy in the cases which should be resolved by this Court. On the contrary, no question of whether an equivalent must have been known at the date of the patent arose in this case, and indeed the Court of Appeals decided that no question of equivalents was involved, and specifically avoided expressing any opinion as to the doctrine of known equivalents (App. 41), which petitioner had tried to inject into the case.

The Court of Appeals has not applied or enunciated any law as to known equivalents. Therefore there is in this case no holding as to the law of known equivalents to be reviewed.

We believe it will help this Court to understand the simple issues involved in this case if we briefly review the salient facts and the careful decision of the Court of Appeals, a court experienced in patent cases.

The Subject Matter.

The Oace patent in suit is concerned with a tape having a pressure-sensitive adhesive (an old type of adhesive) on a backing made of vinyl (plastic) instead of rubber or cellophane or fabric or what not, as in former pressure-sensitive adhesive tapes.

The properties and characteristics of vinyl were well known, including its high insulating quality for electrical purposes (R. I, 79). The advent of plastic tape is the familiar one of a new synthetic material (vinyl) being adopted as time went on for a succession of new uses, where its known properties find useful application.

Vinyl, when mixed with a compatible plasticizer, becomes elastic and pliable substantially in proportion to the amount of plasticizer employed. Prior to the war the available

plasticizers compatible for vinyl were what are known as "liquid" plasticizers, *e.g.*, dioctyl phthalate (DOP). "Liquid" plasticizers are monomeric. That is, they are simple, precise compounds of low molecular weight, in which every molecule is like every other molecule in size and weight (App. p. 35). "Liquid" plasticizers are as thinly fluid as water.

Petitioner, the giant in the tape industry, had recognized that plasticized vinyl (plastic) would be useful for a tape backing because of its known properties, but was unable to make a successful plastic tape because the available compatible plasticizers, being of the liquid type, are migratory, and, if used in sufficient quantity to give to the vinyl tape backing the desired elasticity, migrate into the adhesive and make it pasty (R. I, 50-51, 54, 49).

In 1943 Rohm & Haas, a large and distinguished chemical firm, brought out a new plasticizer (G-25), which is a resin type plasticizer, highly compatible with all vinyls to plasticize them, and non-migratory, as Rohm & Haas publicized when active sales development began in October, 1943.* A resin type plasticizer is a well-known and distinctive type of plasticizer. The resin plasticizers here involved are polymeric, of high molecular weight, viscous like thick molasses, and all the molecules, by polymerization, comprise heavy, sluggish, chemically-linked molecules or chains, so called, of varying high molecular weights (App. 35; R. I, 82, 72-73).

On the advent of G-25, petitioner renewed its interest in plastic tape and tried G-25 as a non-migrating plasticizer (R. I, 48), as did others who had a problem of plasticizer migration (R. I, 34-37).

Petitioner found that when the non-migrating G-25 was used as the sole plasticizer it did not migrate to make the

*Prior to G-25 there was no commercially available non-migrating plasticizer compatible with the high chloride content vinyls required for tape.

adhesive pasty, but for some reason dried out the adhesive and made it non-tacky (R. I, 139). To overcome this defect, petitioner mixed a limited quantity of a liquid plasticizer (DOP) with a resin type plasticizer, and found that this mixture satisfied its requirements (R. I, 48), and made a superior product. Thereupon plaintiff went into production with its commercial plastic tape, in which the vinyl backing was plasticized with a mixture of something under 20 parts of liquid plasticizer (DOP) and the balance of the non-migrating resin plasticizer (G-25) (R. I, 55, 65). And thereafter, on January 12, 1946, the application for the Oace patent in suit was filed. (The patent issued July 10, 1951.)

The Oace Patent in Suit.

The specification describes the prior art substantially as described above—the substitution for rubber of vinyl (col. 1, lines 5 *et seq.*) for its known properties, its use in the form of strips (tapes), and previous efforts to provide such strips or tapes with adhesive. But if less than 20 parts of the "liquid type" plasticizer was used, there was not sufficient elasticity, and if enough was used to give the required elasticity, the plasticizer migrated and the adhesive became tacky (col. 2, lines 27 *et seq.*).

The specification then states (col. 3, l. 21 *et seq.*) that applicants had succeeded in producing permanent equilibrium between backing and adhesive by using the mixture of a "high molecular weight resinous type of plasticizer . . . together with the liquid plasticizer." G-25 is referred to as a "preferred example of a suitable resinous type plasticizer," and other examples were mentioned—ethyl acrylate and vinyl butyl ether (col. 3, lines 40-45).

The specification then states (col. 3, lines 45 *et seq.*) that, while "resinous or high molecular weight modifiers, such

as 'Paraplex G-25' " give the desired stretch and strength, and are "generally classed as non migrating . . . it is surprisingly found that these materials do not provide for permanent equilibrium of adhesive and backing . . . Instead it has been shown that pressure-sensitive adhesives in prolonged contact with highly sensitive and elastic films consisting solely of vinyl polymer and resinous modifier lose a great deal if not all of their tackiness and pressure-sensitivity."

"Liquid" plasticizers other than DOP are referred to (col. 5, line 1 *et seq.*). "Likewise, various compatible non-migrating resinous plasticizers may be substituted" for the G-25 "heretofore mentioned" (col. 5, lines 16-20). The specification states that ethyl acrylate (one of the examples of resin plasticizer previously mentioned) "has somewhat less tendency to cause tack loss than does the 'Paraplex G-25' and hence may be used in greater amounts in many formulations."

The claims of the original patent (see Claim 1 in issue, App. 23) specifically call for the mixture of the two types of plasticizer—a specified amount of "liquid" plasticizer and the balance a resin plasticizer.

The specification, therefore, clearly taught, as the Court of Appeals found "beyond question" (App. 31), that "both types of plasticizer must be used to give good results." The use of either type of plasticizer as the sole plasticizer was disclaimed. Indeed, as the Court of Appeals said (App. 31), the specification is "emphatic" in this regard, as indeed it is.

To support its argument that this finding of the Court of Appeals constitutes an erroneous decision of patent law, petitioner argues that only a man skilled in the art can determine the patent teaching and disclosure and, second, that in the present case the men skilled in the art (the experts of the two parties) are in agreement that the Oace

patent teaches the use of a resin plasticizer as the sole plasticizer and does not teach that both types are to be used.

As this Court stated in *U.S. Industrial Chemicals, Inc.*, v. *Carbide & Carbon Chemicals Corp.*, 315 U.S. 668, 678, a case relied upon by petitioner (Br., p. 13), it is proper to receive expert evidence as to the meaning of technical terms or words of art to aid in understanding "not what the instruments mean, but what they actually say." The meaning of the instrument is for the Court to determine. The experts in this case did testify as to the meaning of "polymer," "liquid plasticizer," "resin type plasticizer," etc., and were in agreement on these matters. And, moreover, the experts were not in agreement, as petitioner repeatedly asserts, that the patent taught and disclosed the use of a resin type of plasticizer as the sole plasticizer. Only petitioner's witness Tierney, an officer of petitioner (App. 31), ventured any such opinion. In the testimony of opposer's expert, DeBell, cited by petitioner to show the "agreement" of the two experts (R. II, 91-92; see Petitioner's Br., p. 10), DeBell testified exactly to the contrary. He stated that, if he tried ethyl acrylate (one of the resin plasticizers referred to in the patent, col. 3, line 43; and see col. 5, line 21), and it worked, I would figure that I had found something new over the patent, because that has already taught me that alone the ethyl acrylate polymer does cause loss of tack."

The patentees of the Oace patent (all petitioner's employees) were presumably people skilled in the art, and they have not agreed that their specification teaches the use of a resin plasticizer as the sole plasticizer. On the contrary, they pointed out to the Patent Office, to distinguish the prior art, that their specification made it "clear" that the "three-way blend" (the vinyl and the liquid and the resin plasticizers) "is essential to the success" of their product, that the specification points out that a liquid plas-

ticizer cannot be used alone and that a resin plasticizer cannot be used as the sole plasticizer (see footnote 4 to Court of Appeals Opinion, App. 31-32).

Nor is there any finding by the Patent Office, as petitioner's brief asserts, that the patent in suit taught and disclosed the use of a resin plasticizer as the sole plasticizer.

Secondly, petitioner (Br., p. 13) cites the paragraph of the patent at col. 5, lines 31-38, as a teaching and disclosure of the use of a resin plasticizer as the sole plasticizer. This paragraph is but the customary patent statement as to ratios or proportions of specified ingredients, and merely says that, where particular ratios of the three ingredients, the vinyl and the two types of plasticizer, are described, those ratios may be altered, etc. There is no teaching or suggestion in this paragraph (or anywhere else in the patent) that any one of the three ingredients may be entirely omitted.

The holding of the Court of Appeals that the District Court's finding as to the teaching and disclosure of the patent was "beyond question . . . clearly erroneous" was not a decision of "an important question of patent law . . . in conflict with the decisions of this Court" (Br., p. 11). Petitioner cites no decision of this Court which holds that a Court of Appeals cannot, as a matter of patent law, reverse a lower court's finding as to the meaning and disclosure of a patent, however clearly erroneous such finding may be. This asserted ground for further review does not bear scrutiny.

No Question of Known Equivalents Involved or Decided by the Court of Appeals in This Case.

Petitioner states as its second basis for further review that the question of whether an equivalent must have been

known at the time of the invention arose in this case, that the existing law as to this question is *not clear, and* that this Court should grant the petition because this case presents an issue of law which should be clarified by this Court.

The question of known equivalents did not arise in this case. The Court of Appeals not only made no decision on this question, but held that the doctrine of equivalents was not involved in this case, and further explicitly refrained from considering or passing on the doctrine of known equivalents, which petitioner had tried to inject into the case (App. 41). Therefore, since the Court of Appeals did not apply or enunciate any law as to the question of known equivalents, there is no holding as to the law of known equivalents to be reviewed.

We submit that we have adequately demonstrated that petitioner has shown no warrant for review in this case.

In the event that this Court has any further interest in the facts and several issues as applied by the Court of Appeals, we attach an appendix in which we summarize the issues and the holding of the Court of Appeals.

Respectfully submitted,

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Appendix.

The original Oace patent issued July 10, 1951, with the first five claims as they appear in the reissue patent. Claim 1 is representative and, bereft of its patent jargon, may be accurately summarized as calling for a pressure-sensitive adhesive insulating tape having (1) *a backing of vinyl* including a major proportion of vinyl chloride (a then commercial vinyl useful for tape), mixed with (2) *a liquid plasticizer* (in an amount of 8 to 20 parts) and (3) *a resin plasticizer*, and (4) *a "rubber resin" type of pressure-sensitive adhesive* (the standard pressure-sensitive adhesives were of the "rubber resin" type).

The facts here summarized are as stated by the Court of Appeals.

The accused tapes were made by Plymouth Rubber Co., which intervened as party defendant in this suit brought against its customer, Sears, Roebuck of Chicago.

In 1950, long prior to the issue of the original Oace patent in July, 1951, Plymouth began manufacture and sale of a plastic tape in which it used as the sole plasticizer a resin type plasticizer of Rohm & Haas, known as G-40, no liquid type plasticizer being used. G-40, which came out in 1945, is a non-migrating resin type plasticizer. Petitioner by early 1946 evaluated it, found it "equivalent to G-25," and found that when used as the sole plasticizer with its adhesives some loss of tack resulted, as was true of G-25 (R. I, 140). G-40 was cheaper than G-25 and petitioner in 1946 substituted in its commercial tape substantially the same quantity of G-40 for its G-25 in its G-25-DOP *mixture* (R. I, 65-66), of its 1945 commercial product.

Subsequently, but prior to this suit, Plymouth also commenced making tape in which G-25 was the sole plasticizer. As we have seen, G-25 was completely resinous.

As we have seen, the Oace patent teaches, as the Court of Appeals found, that *both* a liquid and a resin plasticizer "*must be* used,"* and claim 1, as we have seen, consistently with the teaching of the specification, calls for the use of both of the two distinctive different types of plasticizer, liquid and resin.

Therefore, as the Court of Appeals stated (App. 33), "the crucial inquiry is whether G-25 and G-40 actually contain a liquid as well as a resinous element."

At one stage of the case petitioner contended that, after 1944, G-25 did contain "both liquid and resinous portions" (App. 33). But Tierney on cross-examination admitted that "all portions" of G-25 are resinous (R. I, 67, 74), as found by the Court of Appeals (App. 36). Petitioner now makes no contention that G-25 and G-40 are and always have been other than completely resinous.

The Court of Appeals (App. 29) therefore held that these G-25 and G-40 tapes do not infringe such a claim as claim 1 "because they omit from their production one element or ingredient, to wit, the liquid plasticizer, which is specified in the claims of the patent," a basic principle of patent law not challenged by petitioner.

Petitioner had further contended that G-25 and G-40 contained very heavy molecules and less heavy molecules (as do all resin plasticizers) and that the less heavy molecules perform the function of the liquid plasticizer in making the finished product. The idea seemed to be that there was in G-25 and G-40 some undisclosed molecular weight distribution of resin molecules that would "do the trick" and that G-25 had been changed in this regard since its original manufacture.

*A probable explanation of petitioner's failure with a resin plasticizer as the sole plasticizer would appear to reside in the particular adhesive formula it used.

The Court of Appeals (App. 36) pointed out that even if the lower weight molecules in the resinous plasticizers perform the function of the liquid plasticizers, so that G-25 and G-40 may be used as the sole plasticizer, "it is certain" that the patentees "maintained to the contrary" and use of these plasticizers constitute infringement "because the plasticizer would still be completely resinous whereas the patent teaches that a liquid as well as a resinous plasticizer must be used." The Court of Appeals further pointed out (App. 32) that the Oace patent left it to future investigators to find by their own experimentation a resinous plasticizer that could be used as the sole plasticizer, if they could (or the proper adhesive for use with resin plasticizer). And, if such discovery is made, it is not that of Oace *et al.* and the Oace patent cannot be stretched like a nose of wax to cover a subsequent discovery or advance in the art nowhere described or suggested in the Oace patent.

Where an element or ingredient taught to be essential and included in the claim (here the liquid plasticizer) is omitted, the doctrine of equivalents is not involved and cannot be used to extend coverage beyond and inconsistent with the patent teaching. The patentee "may not recapture," on the ground of equivalency, that which he has disclaimed or rejected (*Acme Steel Co.* v. *Eastern Venetian Blind Co.*, 130 F. Supp. 459, 465; aff. 27 F. 2d 914, 4 Cir.; *Kaumagraph Co.* v. *Superior Trade Mark Co.*, 72 F. 2d 417, 419, 2 Cir.; *James P. March Corp.* v. *U.S. Gauge Co*, 129 F. 2d 161, 7 Cir.; *Banning* v. *Sears, Roebuck*, 88 F. 2d 45, 47, 6 Cir.).

The Reissue. On July 9, 1952, just short of one year after the grant of the original Oace patent with its limited claims specifying liquid and resin plasticizers, petitioner filed application for reissue, to broaden the claims to cover the tapes made by Plymouth and others (utilizing a resin

plasticizer as the sole plasticizer) which petitioner knew of and tested at least as early as May, 1951 (R. I, 151), prior to the issue of the original patent. The reissue was granted with four claims, of which claim 6 (App. 24) is representative. Claim 6, reduced to simple terms, defines a tape with a vinyl backing, plasticized with a plasticizing material "comprising at least a major proportion of a non-migrating viscous plasticizer resin" and the usual adhesive. Just what the scope of this language is may be open to question. "Comprising" has two well-recognized dictionary meanings—it may mean (1) "including" or (2) "consisting of," which would close the claim to any plasticizer ingredient other than resin plasticizer. "It has been established in patent practice that the terms 'comprise' and 'contain' are not exclusive of other materials in contrast with 'consisting of' or 'composed of'" (*Ex parte Glycofrides*, 63 U.S.P.Q. 242, 243, and cases there cited). If in claim 6 "comprising" means "consisting of," then the claim is inconsistent with and antithetical to the Oace specification, which, as we have seen, disclaims the use of a plasticizing material which is solely resinous.

The Court of Appeals did not have to resolve the question of the scope of what it termed "this dubious phrase." For, as the Court said, if the phrase "means that only a resinous plasticizer need be used, the claim is invalid because it goes beyond the disclosure of the original patent; if, on the other hand, the phrase means that both liquid and resinous plasticizers are to be used, the claim is not infringed by the defendants" (App. 36). The Court had earlier pointed out (App. 29)—and again in denying petitioner's motion to reopen (App. 40)—that on authority of the leading case of *U.S. Industrial Chemicals, Inc.*, v. *Carbide & Carbon Chemicals Corp.*, 315 U.S. 668, the reissue claims, if broad enough to cover the use of a resin plasticizer as the sole plasticizer (omitting the

liquid plasticizer prescribed in the original), are invalid. The *Carbide* case is on all fours with the present case, if, as is essential for infringement, the reissue claims are interpreted to cover a plasticizer material in which liquid plasticizer is entirely omitted.

The Court of Appeals had no occasion to consider further sound defenses against the reissue—invalidity because no "error"; invalidity for absence of diligence in filing the broadened application; and defendants' intervening rights. Nor did the Court of Appeals have occasion to consider the question of patentable invention—namely, if the Oace patent covers the use of a non-migrating plasticizer as the sole plasticizer, did it involve patentable invention (even if it can be said that Oace *et al.* were the first to make a tape using resin plasticizer as the sole plasticizer) to adopt a new plasticizer (such as G-25) because of its well-known quality of non-migration, to meet the known requirement of non-migration? (See *Sinclair & Carroll* v. *Interchemical Corp.*, 325 U.S. 327.)